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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,633	12/01/2000	Katsumi Yoshizawa	450100-02891	4183
20999	7590	06/28/2004		
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,633

Applicant(s)

YOSHIZAWA, KATSUMI

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 9-17 have been examined.

Response to Amendment

2. The Amendment filed on 4/22/04 is sufficient to overcome the Kanter, Fredregill, and Hoffman reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 9, 10, 12-14, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (5,537,314) in view of Postrel (6,594,640).

Claim 9, 10, 12-14, 16, 17: Kanter discloses an information processing apparatus, method for processing information concerning electronic commerce in which a customer receiving services offered by a service provider obtains points in accordance with the amount of money having been paid to said service provider, said information processing apparatus comprising: first communication controlling means for controlling data communication with another information processing apparatus via a first network (Fig. 1);

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first recording means for recording information on a plurality of the service providers and information on a plurality of the customers receiving services from said plurality of service providers (Fig. 1);

second communication controlling means for controlling data communication with a financial institution information processing apparatus via a second network (Fig. 1);

payment computing means for computing an amount of money to be refunded to said customer in accordance with the number of the points said customer owns (col 4, lines 59-67; col 7, lines 5-7); and

signal generating means for generating a signal that requests said financial institution information processing apparatus having an account of said customer to transfer a predetermined amount of money to the account of said customer (col 4, lines 59-67; col 7, lines 5-7), wherein: said first communication controlling means controls communication in which a signal corresponding to the amount of money computed by said payment computing means is sent to an information processing apparatus owned by said customer and a signal corresponding to a desired amount of transfer money is received from the information processing apparatus owned by said customer (col 4, lines 59-67; col 7, lines 5-7); and

said second communication controlling means controls communication in which the signal generated by said signal generating means is sent to said financial institution information processing apparatus and a signal representing completion of processing by said financial institution information processing apparatus is received (col 4, lines 59-67; col 7, lines 5-7; col 22, lines 20-50; col 22, line 60-col 23, line 2; col 23, lines 25-45; col 27, lines 40-50).

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Kanter further discloses key generating means for generating an encryption key for encrypting and decoding communication data (col 17, lines 53-60; col 17, lines 62-67; col 18, line 65-col 19, line 2; col 23, lines 45-55).

Kanter further discloses authenticating means for authenticating said other information processing apparatus with which communication is controlled by said first communication controlling means (col 17, lines 53-60; col 17, lines 62-67; col 18, line 65-col 19, line 2; col 23, lines 45-55).

Kanter further discloses receiving means for receiving a point redemption request for redeeming points owned by said customer for money, said point redemption request including information on the number of points which is desired to be redeemed for money from among the total points owned by said customer (col 4, lines 59-67; col 7, lines 5-7); transferring means for transferring, to an account of said customer, an amount of money corresponding to the desired number of points in the information included in said point redemption request from among the total points (col 4, lines 59-67); and updating means for updating the total points corresponding to said customer (col 24, lines 6-18).

Kanter does not explicitly disclose updating means for updating the total points corresponding to said customer by subtracting the desired number of points in the information included in said point redemption request from the total points owned by said customer.

Since Kanter discloses the customer having a total points and the customer redeeming the points for cash, it is obvious that Kanter would balance the account of the customer after a points redemption.

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Kanter does not explicitly disclose e-commerce over an open network.

However, Postrel discloses e-commerce over an open network (Fig. 4; Fig. 5; col 5, lines 31-36; col 1, lines 13-17; col 1, lines 50-53).

Postrel further discloses a point issuing system and point redemption system which are separate from the plurality of service providers (Fig. 5).

Postrel further discloses that all points control, transfer, redemption, tracking services, can be performed by a server or service separate from the user or merchant (Fig. 4; Fig. 5).

Postrel further discloses authenticating the customer (col 11, line 61-col 12, line 1; col 6, lines 3-7).

Postrel further disclose updating means for updating the total points corresponding to said customer by subtracting the desired number of points in the information included in said point redemption request from the total points owned by said customer (col 5, lines 50-60; col 1, lines 13-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Postrel's utilization of merchant's accessible over the Internet to Kanter's utilization of multiple merchants. One would have been motivated to do this in order to allow Kanter's users to access a wider range of merchants.

4. Claim 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (5,537,314) in view of Postrel (6,594,640) in further view of Hoffman (6,012,039).

Claim 11, 15: Kanter and Postrel disclose an information processing apparatus according to Claim 9, 14. Kanter further discloses wherein said authenticating means authenticates said

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other information processing apparatus based on a unique identifier thereof which is received under the control of said first communication controlling means and which is issued from an authority connected to said first network (col 17, lines 53-60; col 17, lines 62-67; col 18, line 65- col 19, line 2; col 23, lines 45-55).

Kanter does not explicitly disclose that said authenticating means authenticates based on a certificate issued from a predetermined certificate authority connected to said first network.

However, Hoffman discloses authenticating means authenticates based on a certificate issued from a predetermined certificate authority connected to said first network (col 10, lines 43-55; col 13, lines 10-20; col 14, lines 60-70; col 7, lines 65-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Hoffman's utilization of digital certificates over to Kanter's authenticated transmissions. One would have been motivated to do this because digital certificates are one standard for authenticated transmissions that is popular in the industry.

Response to Arguments

5. Applicant's arguments with respect to claims 9-17 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

Additionally, as noted in the rejection above, Postrel discloses e-commerce over an open network (Fig. 4; Fig. 5; col 5, lines 31-36; col 1, lines 13-17; col 1, lines 50-53).

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Postrel further discloses a point issuing system and point redemption system which are separate from the plurality of service providers (Fig. 5).

Postrel further discloses that all points control, transfer, redemption, tracking services, can be performed by a server or service separate from the user or merchant (Fig. 4; Fig. 5).

Postrel further discloses authenticating the customer (col 11, line 61-col 12, line 1; col 6, lines 3-7).

Postrel further disclose updating means for updating the total points corresponding to said customer (col 5, lines 50-60; col 1, lines 13-17).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AO

6/21/04


JAMES W. MYHRE
PRIMARY EXAMINER